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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,842	01/24/2001	Toshiyuki Waida	1081.1104/DSG	3353

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EXAMINER

KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3693

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04/28/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/767,842

Applicant(s)

WAIDA ET AL.

Examiner

STEFANOS KARMIS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,6,9 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,6,9 and 11-15 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following communication is in response to Applicant's amendment filed 05 February 2009.

Status of Claims

2. Claims 1, 6 and 15 are currently amended. Claims 1, 4, 6, 9, 11-15 are currently pending and under prosecution.

Claim Objections

3. Claim 9 is objected to because of the following informalities: Claim 9 is listed as being dependent on the "apparatus of claim 1." However, claim 1 is drawn to a method. Independent claim 6 is drawn to an apparatus. The Examiner believes Applicant intended to have claim 9 dependent claim 6. Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1, 4, 11, 12 and 15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Independent claim 1 recites a process comprising the steps of acquiring, searching, determining, recovering, etc. Based on Supreme Court precedent, a proper process must be tied

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to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Simply reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Independent claim 15 is rejected based on similar reasoning to claim 1. Claims 4, 11 and 12 are rejected based on their dependency to claim 1.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 4, 6, 9, 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrases "judging whether or not" and "character-recognizing...if judged" and "determining whether or not" render the claim indefinite because these claims steps are not positively recited and instead are conditional. For example, it is not clear what happens

when a hyphen is not judged to be part of the hyphen arrangement and whether art reading on this limitation would thus read on the claims because the remaining limitations in the claim would no longer be required. Further it is not clear how the form is discriminated as suggested in the preamble of the claim. Claims 4, 6, 9, 11-15 are rejected under similar reasoning. The Examiner suggests amending the claims to recite active steps so that patentable weight is given to all steps in the claim.

The Examiner believes a telephone interview would be beneficial to assist the Applicant in amending the claims into active limitations with full patentable weight. This would assist overcoming this rejection and help to overcome the prior art. Therefore, the Examiner invites the Applicant to schedule an interview at Applicant's convenience.

Response to Arguments

8. Applicant's arguments with respect to claims 1, 4, 6, 9 and 11-15 have been considered but are moot in view of the new ground(s) of rejection.

9. Applicant argues that Krouse in view of Kolling fails to teach searching for the payee account number in the image data at an unknown position in accordance with an account number searching rule, and determining a type of the form based on the payee account number from a document information table the stores account numbers correlated with types of form.

The Examiner Respectfully disagrees. Krouse teaches searching various types of documents that contain account numbers in various different positions (column 18, lines 31-34; and Figures 8A-8F; Examiner notes that the account number (408) is located in various positions). Therefore, when the form is first scanned, the form is unknown and therefore the

locations of the account number is unknown. Therefore Krouse further teaches searching for the payee account number in the image at an unknown position (column 12, lines 63 thru column 13, line 11 and column 14, lines 17-63 and column 18, lines 31-34; Examiner notes that a user could physically search the different invoice types to locate the account numbers in an unknown position since the searching is not tied to a processor or computer instructions) and determining a type of the form based on the payee account number from a document information table that stores account numbers correlated with types of the form (column 14, line 44 thru column 15, line 10 and column 18, lines 31-34). Therefore, Applicant's arguments are not persuasive.

10. Applicant also argues that Krouse in view of Killing fails to teach searching for hyphens in the image data and character recognizing the image data in areas surrounding the searched hyphen to determine whether an account number is matched.

The Examiner respectfully disagrees. The Examiner acknowledges that Krouse fails to teach searching for the account number using a rule that searches for hyphens in the image and recognizes the payee account number in areas surrounding a hyphen found in the image. Kolling teaches an electronic statement presentment system. A template authoring workstation is used in conjunction with authorizing tools to present billing information (column 9, lines 53-67).

Kolling teaches the use of OCR on scanned images to acquire the necessary information to present the billing information (column 10, lines 10-34). Kolling further teaches a universal biller file which is a database of biller information and includes a record for each biller in the system (column 14, lines 42-49). Kolling teaches that biller information includes information including information describing the biller company name, address, telephone and contains

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information that identifies the formats for a customer biller account number that the biller accepts from the customer (column 14, lines 50-67). The account numbers have particular formats including hyphens which recognize the account number as being acceptable (column 14, lines 50-67). As discussed above it is unclear what Applicant considers to be a hyphen arrangement and therefore, given the broadest reasonable interpretation, Kolling teachings of recognizing an account number pattern by locating a hyphen conforms to judging whether the account number has a specified hyphen arrangement. Therefore, Applicant's arguments are not persuasive.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 4, 6, 9 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krouse et al. (hereinafter Krouse) U.S. Patent 6,097,834 in further view of Kolling et al. (hereinafter Kolling) U.S. Patent 6,385,595.

Regarding independent claim 1, Krouse teaches a financial transaction processing system and method, comprising: acquiring an image of the form by optically reading the form (column 12, lines 38-62); searching for the payee account number in the image at an unknown position

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(column 12, lines 63 thru column 13, line 11 and column 14, lines 17-63 and column 18, lines 31-34; Examiner also notes that a user could physically search the different invoice types to locate the account numbers in an unknown position since the searching is not tied to a processor or computer instructions); determining a type of the form based on the payee account number from a document information table that stores account numbers correlated with types of the form (column 14, line 44 thru column 15, line 10 and column 18, lines 31-34); and recovering other data from locations according to the determined type of form (column 14, line 44 thru column 15, line 10).

Krouse fails to teach searching for the account number using a rule that searches for hyphens in the image and recognizes the payee account number in areas surrounding a hyphen found in the image. Kolling teaches an electronic statement presentment system. A template authoring workstation is used in conjunction with authorizing tools to present billing information (column 9, lines 53-67). Kolling teaches the use of OCR on scanned images to acquire the necessary information to present the billing information (column 10, lines 10-34). Kolling further teaches a universal biller file which is a database of biller information and includes a record for each biller in the system (column 14, lines 42-49). Kolling teaches that biller information includes information including information describing the biller company name, address, telephone and contains information that identifies the formats for a customer biller account number that the biller accepts from the customer (column 14, lines 50-67). The account numbers have particular formats including hyphens which recognize the account number as being acceptable (column 14, lines 50-67). Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the character

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recognition and comparing those to reference recognition characteristics teachings of Krouse to include account numbers in a specified format because it identifies and associates the financial document for appropriate processing and presentation based on recognized characters.

Independent claims 6 and 15 are substantially similar to claim 1 and therefore are rejected under similar reasoning.

Claims 4 and 9, Krouse teaches recognizing a plurality of account numbers on the payment form (column 14, lines 17-63); and merging a plurality of results, which have recognized to determine the payee account number (column 14, lines 17-63; Examiner notes that the plurality of recognized characters are merged together for an account number). Kolling also teaches merging a plurality of numbers to determine a payee account number in accordance with the proper format (column 14, line 50 thru column 15, line 15).

Regarding claims 11 and 13, Krouse teaches character recognition teachings (column 14, line 44 thru column 15, line 10 and column 18, lines 31-34). Kolling teaches determining if an account number including hyphens conforms to the account number scheme (column 14, line 50 thru column 15, line 15). Therefore it would be obvious to one of ordinary skill in the art to have modify the character recognition teachings of Krouse to include searching for the hyphen with the account conforming teachings of Kolling because it assists in processing the financial form based on a customer/account identifier.

13. Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krouse et al. (hereinafter Krouse) U.S. Patent 6,097,834 in further view of Kolling et al. (hereinafter Kolling) U.S. Patent 6,385,595 in further view of Geisel et al. U.S. Publication 2002/0073060.

Regarding claims 12 and 14, Krouse in view of Kolling teaches character recognition when reading an account number. Krouse in view of Kolling fails to specify merging a result from a rejected number of a plurality of character recognition results and a number of recognition characters. Geisel teaches a computer implemented method for item processing that provides confidence-based matching of unreadable characters during character recognition in an attempt to determine the proper character (page 3, paragraph 0036). Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Krouse in view of Kolling and include merging results from a reject number of plurality of said character recognition and recognition characters because it allows for accurately reading account numbers even when there could be a minor or obvious exception in the account number.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEFANOS KARMIS whose telephone number is (571)272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted
/Stefanos Karmis/
Primary Examiner, Art Unit 3693
25 April 2009